



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,223	10/17/2000	Dennis Ray Berman	29554.3	1492

7590

04/24/2002

David L McCombs  
Haynes and Boone LLP  
901 Main Street Suite 3100  
Dallas, TX 75202-3789

EXAMINER

HARRIS, CHANDA L

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 04/24/2002

*Handwritten signature/initials*

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/690,223

Applicant(s)

BERMAN, DENNIS RAY

Examiner

Chanda L. Harris

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-23 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 9-11, 13 and 15-17 is/are rejected.
- 7) ☒ Claim(s) 4, 8 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Objections*

Claim 3 is objected to because of the following informalities: 'key word' should be 'keyword'. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**Claims 1-2, 5-7, 9-11, 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Breland et al. (US 6,254,395).**

1. [Claims 1 and 12]: Regarding Claims 1 and 12, Breland discloses a presentation process for presenting at least one knowledge topic to the learner and for prompting the learner to enter a learner constructed response thereto. See Abstract. Breland

discloses an evaluation information process for providing keyword data that corresponds to the knowledge topic. See Col.5: 29-39. Breland discloses an evaluation process for determining, based upon entry of a learner-constructed response to the knowledge topic, success or failure being determined by comparison of the learner-constructed response with the keyword data. See Col.5: 66-Col.6: 11.

2. [Claim 2]: Regarding Claim 2, Breland discloses wherein the comparison comprises a determination of whether or not expected keyword data appears in the learner-constructed response. See Col.5: 66-Col.6:11.

3. [Claims 5 and 15]: Regarding Claims 5 and 15, Breland discloses wherein upon a determination of success of the learner, the learner is not further prompted to enter a learner-constructed response for the topic. See Col.6: 7-9.

4. [Claims 6 and 16]: Regarding Claims 6 and 16, Breland discloses wherein the comparison comprises a determination of whether or not expected keyword data appears in the learner-constructed response, the keyword data comprising at least one exact keyword. See Col.5: 64-67.

5. [Claim 7]: Regarding Claim 7, Breland discloses wherein the comparison comprises a determination of whether or not expected keyword data appears in the learner-constructed response, the keyword data comprising at least one exact phrase. See Col.4: 14-19, 34-42.

6. [Claim 9]: In light of Col.5: 66-67, Claim 9 is considered to be inherent feature of Breland's invention.

Art Unit: 3714

7. [Claim 10]: Regarding Claim 10, Breland discloses wherein the comparison comprises a determination of whether or not expected keyword data appears in the learner-constructed response, the keyword data comprising at least one related word. See Col.5: 62-66.

8. [Claims 11 and 17]: Regarding Claims 11 and 17, Breland discloses comprising a reporting process for analyzing information regarding a performance of at least one learner during the presentation process, the evaluation information process and the evaluation process, and reporting an analyzed result to at least one predetermined party. See Col.6: 7-11.

**Claims 1-2, 5-7, 9-12, and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Ziv-El (US 6,302,698).**

1. [Claims 1 and 12]: Regarding Claims 1 and 12, Ziv-El discloses a presentation process for presenting at least one knowledge topic to the learner and for prompting the learner to enter a learner constructed response thereto. See Col.9: 46-53. Ziv-El discloses an evaluation information process for providing keyword data that corresponds to the knowledge topic and an evaluation process for determining, based upon entry of a learner-constructed response to the knowledge topic, success or failure being determined by comparison of the learner-constructed response with the keyword data. See Col.11: 24-36.

2. [Claim 2]: Regarding Claim 2, Ziv-El discloses wherein the comparison comprises a determination of whether or not expected keyword data appears in the learner-constructed response. See Col.11: 24-29.
3. [Claims 3 and 13]: Regarding Claims 3 and 13, Ziv-El discloses wherein the keyword data comprises primary keywords or phrases (i.e. particular strings), related keywords or phrases, and synonyms. See Col.12: 16-27 and Col.18: 49-65.
4. [Claims 5 and 15]: Regarding Claims 5 and 15, Ziv-El discloses wherein upon a determination of success of the learner, the learner is not further prompted to enter a learner-constructed response for the topic. See Col.26: 16-21.
5. [Claims 6 and 16]: Regarding Claims 6 and 16, Ziv-El discloses wherein the comparison comprises a determination of whether or not expected keyword data appears in the learner-constructed response, the keyword data comprising at least one exact keyword. See Col.5: 64-67.
6. [Claim 7]: Regarding Claim 7, Ziv-El discloses wherein the comparison comprises a determination of whether or not expected keyword data appears in the learner-constructed response, the keyword data comprising at least one exact phrase (i.e. particular string). See Col.12: 16-26.
7. [Claim 9]: Regarding Claim 9, Ziv-El discloses wherein the comparison comprises a determination of whether or not the learner-constructed response fails a lexical analysis. See Cols.13 and 14.
8. [Claim 10]: Regarding Claim 10, Ziv-El discloses wherein the comparison comprises a determination of whether or not expected keyword data appears in the

Art Unit: 3714

learner-constructed response, the keyword data comprising at least one related word.

See Col.12: 16-27.

9. [Claims 11 and 17]: Regarding Claims 11 and 17, Ziv-El discloses comprising a reporting process for analyzing information regarding a performance of at least one learner during the presentation process, the evaluation information process and the evaluation process, and reporting an analyzed result to at least one predetermined party. See Col.26: 22-58.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.. Patentability shall not be negated by the manner in which the invention was made.

**Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breland.**

[Claims 3 and 13]: Regarding Claims 3 and 13, Breland does not disclose expressly wherein the keyword data comprises primary keywords or phrases, related keywords or phrases, and synonyms. However, such features would have been obvious to one of ordinary skill in the art to incorporate into Breland's invention in light of Col.5: 62-Col.6: 7, 20-27 for the purpose of providing matching data corresponding to all of the possible solutions to Breland's system.

***Allowable Subject Matter***

1. Claims 18-23 are allowed.
2. The following is a statement of reasons for the indication of allowable subject matter: Patentability is seen in, although not limited to, the combination including the method comprising the step of, "upon a determination of failure of the learner, providing remedial information to the learner and again prompting the learner to enter a learner-constructed response" (Claim 18). The prior art of record does not teach or fairly suggest this feature in the combination.
3. Claims 4, 8, and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Citation of Pertinent Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Neumeyer et al. (US 6, 226,611)  
-language instruction
- Ferris et al. (US 5,011,413)  
-figural response testing



- Burstein et al. (US 6,115,683)
  - automatic essay scoring
- Bishop et al. (US 4,958,284)
  - open ended question analysis
- Driscoll et al. (US 5,987,302)
  - on-line essay evaluation system
- Poor (US 6,256,399)
  - scoring for open-ended assessments
- Burstein et al. (US 6,181,909)
  - automatic essay scoring
- Clark et al. (US 6,168,440)
  - scoring system
- Kucinski et al. (US 6,311,040)
  - scoring for open-ended questions
- Foltz et al. (US 6,356,864)
  - analyzing and evaluating writing
- Jongsma et al. (US 6,267,601)
  - holistic scoring of open-ended scoring
- O'Brien (US 6,287,123)
  - computer managed learning
- Bejar et al. (US 6,295,439)
  - evaluation of constructed responses

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chanda L. Harris whose telephone number is 703-308-8358. The examiner can normally be reached on M-F 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Chanda L. Harris  
Examiner  
Art Unit 3714

ch.  
ch.  
April 17, 2002

Joe H. Cheng  
Primary Examiner